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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,022	12/26/2001	Michael Roberts	00216-368004	2417
26161	7590	03/22/2011		
FISH & RICHARDSON P.C. (BO)			EXAMINER	
P.O. BOX 1022			SPISICH, MARK	
MINNEAPOLIS, MN 55440-1022				
			ART UNIT	PAPER NUMBER
			3727	
			NOTIFICATION DATE	DELIVERY MODE
			03/22/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No. 10/036,022	Applicant(s) ROBERTS ET AL.	
	Examiner Mark Spisich	Art Unit 3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 52-54 and 57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 52-54 and 57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

In response to the amendment filed 15 February 2011 (amendment after BPAI decision), prosecution is re-opened.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 52-54 and 57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The application as originally filed does not support the invention as currently claimed. The only mention of injection molding pertains to the class of elastomeric materials meant to be included in reference to "thermoplastic elastomer" (page 3, lines 21-25). There is no mention that any element of the claimed "oral brush" is made specifically by injection molding. The only subsequent mention of any element or component being molded is found on page 4 (line 29) and page 10 (last 6 lines) and this is simply a general reference to molding (the element to a spacer).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 52-54 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo (JP 1-72128). The prior comments of the examiner as well as the BPAI decision of 17 December 2010 are hereby incorporated by reference and the comments herein are limited to the amendment filed 15 February 2011. The only issue pertains to the recitation that the elastomeric element is injection molded. As mentioned before, the elastomeric elements of the present applicant are made of any thermoplastic elastomer material which, among other things, may be made by "plastics processing methods which are well known in the art, such as extrusion or injection molding" (page 3, lines 21-25). A significant portion of the specification includes a description of the element(s) as being extruded. There was no criticality established with respect to the manner of forming the (elastomeric) element(s). If applicants were aware of the deficiencies of extruding (as alluded to in the 1.132 declaration), then why was essentially the entire applicant drawn to embodiments which were extruded? As such, the elastomeric elements of '128 could be made by any known method of molding (the BPAI already concluding that the "melt-spinning" is a form of molding), of which injection is a well known method of forming.

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5. Claims 52-54 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Libby (USP 1,251,250) in view of JP 1-72128 and Van Niekerk (USP 5,072,479). The patent to Libby discloses an oral brush comprising a handle (1), head (2) with a plurality of non-elastomeric bristles (7) as well as a plurality of elastomeric elements (14) which are an integral formation (5) of a rubber-like material (page 1, lines 54-63). With regard to the particular elastomer material, '128 teaches that such is known as being useful in an oral care implement (a brush). One of ordinary skill would deem it obvious to utilize any known material recognized in the art as being suitable for the intended use. *In re Leshin*, 125 USPQ 416. The BPAI already addressed the Shore hardness issue. It is safe to assume that the member (5) of Libby is molded in some fashion. Regarding the material chosen for the elastomer, '128 teaches that the claimed material (styrenic block copolymer) is known in the art as being suitable for use in a oral brush. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Van Niekerk discloses that it is well known to form elastomer bristles in an injection molding method and that any known method known at present for forming single piece articles (such as the member 5 of Libby) would be obvious to one of ordinary skill in the art.

Response to Arguments

6. Applicant's arguments filed 15 February 2011 have been fully considered but they are not persuasive. First, there issue pertaining to the hardness of the elastomer is a non-issue at this point. The BPAI already decided this matter. If

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applicant wanted to pursue this line of argument, they should have filed a request for reconsideration or appeal to the Federal Circuit. No further comments will be made with regard to the hardness. The only issue pertains to the recitation (as amended) that the "element" is injection molded. The BPAI had earlier concluded that the '128 patent, which taught melt spinning, taught a type of molding. Even conceding that there might be a benefit (versus extruding) to forming them in this manner, it would still be obvious to form the elements of '128 in any manner well known in the art. The specification as originally filed also provides no criticality to the manner of forming the elements. In fact, most of the "elements" in the applicant (with the exception of the ones attached to the spacer of Figures 6 and 7) are made by extrusion. Applicant must not have known that this method was so undesirable when they filed the application. There is also a question as to whether it even supports the recitation that the elements are injection molded in the first place. To address the injection molding issue in a different manner, the additional new ground of rejection has been made in the action.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is

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filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Spisich whose telephone number is (571) 272-1278. The examiner can normally be reached on M-Th (5:30-3:00), Alternate Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Spisich/
Primary Examiner, Art Unit 3727

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